



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,433	10/14/2003	W. Todd Daniell	190250-1580	7279
38823 7590 02/18/2009 AT&T Legal Department - TKHR Attn: Patent Docketing One AT&T Way Room 2A-207 Bedminster, NJ 07921				
EXAMINER				
LAI, MICHAEL C				
ART UNIT		PAPER NUMBER		
2457				
MAIL DATE		DELIVERY MODE		
02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,433

Applicant(s)

DANIELL, W. TODD

Examiner

MICHAEL C. LAI

Art Unit

2457

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 11, 18-20 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 11, 18-20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 9/3/2008, 1/23/2009
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to amendment filed on 11/10/2008.

Response to Amendment

The examiner has acknowledged the amended claim 27. The objection to claim 27 has been corrected and withdrawn accordingly. The 112 rejections to claims 10-11 and 26 are withdrawn. Claims 1-2, 10-11, 18-20, and 25-27 are pending.

Response to Arguments

Applicant's arguments filed 1/8/2008 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that: A) More specifically, claim 26 clearly recites a "computer-readable medium for handling digital messages, the computer-readable medium including a program that when executed by a computer performs at least the following..." (line 1). As illustrated here, the structure of claim 26 clearly precludes any nonstatutory embodiments that may or may not be disclosed in the written description. B) Further, 35 U.S.C. §102(e) states a "person shall be entitled to a patent, unless..., the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent." As illustrated above, Malik does not qualify as a prior art reference under this section. Further, as the provisional applications of Malik do not appear to be published, these applications may not qualify as prior art under this section.

In response to A) Claims 26-27 recite the limitation of "computer-readable medium..." that is described in lines 3-8 on page 27 of original specification as "In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, **propagate**, or **transport** the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium." A propagation medium includes signals. As such, the claims cover embodiments directed to signals, per se. The examiner suggests separating computer-readable storage medium from computer-readable transmission (or propagation) medium in the specification, and replacing "computer-readable medium" with "computer-readable storage medium" in the claims. Transmission medium is non-statutory.

In response to B) Examiner's interpretation based on this express intent to apply the provisions of Title 35 relating to "applications for patent" to provisional applications (except for four enumerated sections noted in §111(b)(8)), a provisional application can therefore be reasonably considered an "application for patent" within the meaning of §102(e). The plain meaning of these provisions of Title 35 as noted above is outlined in MPEP 2136.03(111) for establishing the critical reference date under §102(e) of a U.S. patent or U.S. application publication that is entitled to the benefit of the filing date of a provisional application under §119(e). Board of Patent Appeals and Interferences held that U.S. provisional patent applications act as prior art under 35 U.S.C. §102(e) as their filing date, rather than the year-later filing date of any corresponding utility patent

application. Furthermore, in a directive issued to the general public on 11/23/2004, Stephen G. Kunin (Deputy Commissioner for Patent Examination Policy) indicated that most publicly available provisional applications can now be viewed over the Internet (see <http://www.uspto.gov/web/offices/com/sol/og/2004/week47/patapps.htm>). As such, Malik is clearly qualified as prior art.

Thus, in view of such, the rejection is sustained as follows:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 26-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26-27 recite the limitation of "computer-readable medium..." that is described in lines 3-8 on page 27 of original specification as "In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, **propagate**, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium." A propagation medium includes signals. As such, the claims cover embodiments directed to signals, per se. These claims are being rejected as non-statutory as directed to a form of energy rather than a patent-eligible machine, manufacture, process or

composition of matter. The examiner suggests separating computer-readable storage medium from computer-readable transmission (or propagation) medium in the specification. Transmission medium is non-statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 10-11, 18-20, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (US 2004/0078445 A1, hereinafter referred to as Malik).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Malik discloses a method for handling digital messages, the method comprising:

determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account [para. 0049, lines 1-6];

in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender [para. 0049, lines 14-27].

Regarding claim 2, Malik further discloses the method of claim 1, wherein determining whether a sender of a received email message is currently present at an IM account includes extracting contact information from the email message, the contact information being associated with the sender of the received email message [para. 0089, lines 4-9].

Claims 10-11 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Claim 18 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Claims 19-20 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Claim 25 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Claims 26-27 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Appelman et al. (US 6,912,564 B1) discloses a system for instant messaging the sender and recipients of an e-mail message.

Jenniges et al. (US 6,978,136 B2) discloses a method for automatically initiating a chat session between a user and personnel in the customer support department when the controller indicates that the customer support department is available.

Stewart et al. (US 7,317,928 B2) discloses exposing instant messenger presence information on a mobile device.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
06FEB2009

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457